

**REMARKS**

Claims 6-12 are pending in the present application. Claims 6, 7, 8 and 10 have been amended to clarify the scope of the invention. Support for claim amendments can be found throughout the specification and in the original claims more particularly page 3, line 28-34, page 4, lines 1-2, page 5, lines 4-6 (solvents are visible) and lines 9-16. Claim 14 has been added. No new matter has been added. Support for claim 14 can be found in the original claims.

The issues outstanding in this application are as follows:

- Claims 6-8, 10, 12 and 13 were rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Litborn et al. (WO 98/33052).
- Claims 9 and 11 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable by Litborn et al. (WO 98/33052) in view of Mian et al. (US 6,319,469).

Applicant respectfully traverse the outstanding rejections, and Applicants respectfully requests reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

I. Rejection under 35 U.S.C. § 102(a)

Claims 6-8, 10, 12 and 13 are rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Litborn et al. (WO 98/33052). Applicants respectfully traverse.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegel Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

Applicant asserts that the covering liquid as taught by Litborn is a liquid that is immiscible with the sample liquid, such as it floats on top of the sample and acts as a liquid lock to prevent evaporation of the liquid sample. As a consequence of the covering liquid being immiscible with the sample liquid, reactions can not be carried out in the covering liquid due to the absence of the sample in the covering liquid. See page 5, lines 11-15, page 7, line 20, page 12, lines 2-3. Since the covering liquid in Litborn is not miscible with the sample and no reactions are supposed to take place in the covering liquid, the covering liquid of Litborn can not be used as a replacing solvent as described in the present invention. The replacing solvent of the present invention is miscible with the sample as claimed in newly amended independent claims 6 and 8.

In the Action, the Examiner refers to page 9, lines 27-30 of Litborn which states “it can also be of value to include one or more of the reactants to be used in the operation in said covering liquid to feed the same, even sequentially, to the reaction”. Applicant asserts that this passage of Litborn does not make Litborn’s method closer to the present invention. Litborn still teaches the use of two liquids that are immiscible – one in which the reactions are performed and a second liquid that covers the first liquid to prevent its evaporation during the reactions. In the present invention, evaporation is allowed and no covering liquid is needed. In other words, the present invention and Litborn’s invention have the same general goal – to prevent desiccation - but they reach the goal in diametrically opposite ways.

Applicant asserts that Litborn et al. teaches preventing desiccation of aqueous samples in a way that is completely different from the present invention. In light of the arguments, Applicant request that the rejection be withdrawn.

## II. Rejection under 35 U.S.C. § 103(a)

Claims 9 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Litborn et al. (WO 98/33052) in view of Mian et al. (6,319,469). Applicants respectfully traverse.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The present invention is drawn to a method for preventing desiccation by continuous replacement of that evaporates from a sample placed on a microarea, wherein the sample comprises one or more reactants and a solvent that is miscible with the sample as illustrated in independent claim 8. As indicated above, the immiscible covering liquid of Litborn is not the same as the miscible solvent of the present invention.

Since claims 9 and 11 are dependent from claim 8 and incorporate all the limitations of independent claim 8, claims 9 and 11 are nonobvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, Applicant respectfully requests that the rejection be withdrawn.

## CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

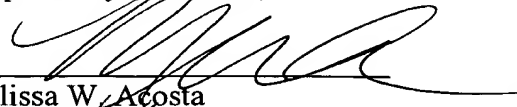
Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. 10102583 from which the undersigned is authorized to draw.

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Respectfully submitted,

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